

REMARKS

For the convenience of the Examiner set forth below is a recapitulation of the current status of the Claims in the present Application.

CLAIM	STATUS	DEPENDENCY
1	Previously presented	Independent
2	Original	1
3	Original	1
4	Canceled	
5	Canceled	
6	Original	1
7	Previously presented	1

Comments of Examiner Rochelle BLACKMAN have been reviewed carefully along with pertinent sections of the Patent Act, Patent Rules, the Manual of Patent Examining Procedure, legal treatises and relevant decisional law. The Application has been amended in accordance with Examiner BLACKMAN's requirements and allowance of the Application, as amended, is solicited earnestly.

Claims 1-3 and 7 have been rejected under 35 USC 102(b) as being anticipated by *Kouchi, et al.*, (EP Patent 326668).

Claims 1-3, 6 and 7 have been rejected as being unpatentable over *Finizio et al.* (U.S. Patent Publication No. 2003/0095800) in view of *Kouchi, et al.*, (EP Patent 326668).

Reconsideration of the Examiner's rejection of Claims 1-3 and 6 is requested on the following basis. An examination of the *Kouchi, et al.*, patent and the *Finizio et al* publication reveals the following differences between the structures shown thereon, the structure of the present invention and the statements of the Examiner.

1. Neither *Kouchi* nor *Finizio* taken alone or together disclose the primary subject matter of the present invention as explained below.
2. A key objective of the present invention is to provide a light device that has light a concentrating device to concentrate light and increase distance to which the light projects. Claim 1 of the present application claims that "plurality of lenses provided therein and arranged in front of said light members, for concentrating the lights generated by said light members." The specification (detail description, page 4, line 7) and the drawings (Fig. 4) also show that the lenses are convex and are used to concentrate light. Therefore, the lenses of the present invention must be able to concentrate light.
3. *Kouchi* disclosed in line 45 in column 4 that "The light is dispersed by a corresponding one of the lens section 12a of the inner lens element 12 such that . . ." *Kouchi*

obviously disclosed lenses that are used to disperse lights. “Concentrate” means to gather light rays together, but “disperse” means to make light rays diverge. Furthermore, the lens that is required in the present invention and the lens that is required in *Kouchi* are totally different. Also in Fig. 2, *Kouchi* shows the lenses 12a are concave lens obviously

4. Based on principles of optics, convex lenses are used to gather light together, and concave lenses are used to separate light. Therefore, *Kouchi* fails to disclose a lens that is used to concentrate lights either in the specification or in the drawings. Thus, *Kouchi* fails to disclose all limitations in Claim 1 of the present invention. Claim 1 of the application should overcome the rejection under 35 U.S.C.102(b).

5. Furthermore, *Kouchi* discloses a lens opposite to the lens of the present invention so that using the lens of the present invention based on the teaching of *Kouchi* is non-obvious for a person having ordinary skill in the art.

6. Moreover, *Finizio* does not show the lens that is mounted in front of the light member. *Finizio* just shows a plate mounted in front of the light member. Even though *Kouchi* teaches that multiple lenses are mounted on the plate, as described before, *Kouchi* fails to teach the same lenses claimed in Claim 1 of the present application and cannot achieve the main objective of the present invention. Therefore, Claim 1 of the present invention is believed to be patentable over *Finizio* in view of *Kouchi* and should be considered to be non-obvious for a person having ordinary skill in the art. Claim 1 should overcome the rejection under 35 U.S.C.103 (a).

7. Because Claim 1 of the present invention is believed to overcome the rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a). Claims 2, 3, 6 and 7 which depend from Claim 1

and are also believed to overcome the rejections under 35 U.S.C.102(b) and 35 U.S.C.103(a).

8. The Examiner has stated that:

Finizio discloses projector light device (22) comprising: a housing (20) including a supporting panel (see 72) provided therein, a board (see PCB 70 in pg. 3, paragraph [0034]) attached to said panel, a plurality of light members (68) attached to said board for generating lights, and a plate (74) disposed in front of said board, arranged in front of said light members, for concentrating the light generated by said light members, and for increasing projecting distances of the lights generated by said light members, a cover (40) disposed in front of said plate, and including a transparent sheet (see 60) provided therein, and arranged in front of said light members,

The Examiner has stated further:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the “plate” of the “projector light device” of *Finizio* reference with a plurality of lenses, wherein each of the plurality of lenses are in general alignment with one of the plurality of the light members as taught by *Kouchi* for the purpose dispersing the light and giving the light a suitable luminous intensity characteristic (see col.4, lines 45-48).

9. Examination of the *Finizio et al.* reference reveals that plate 74 is not a device for concentrating light as stated by the Examiner but rather an infrared passband filter (Paragraph 0035). The *Finizio et al.* reference thus does not anticipate the present invention or does it render the present invention obvious because the elements of *Finizio et al.* cited by the Examiner do not perform and can not perform the functions of a lens and therefore do not function in a manner similar to the elements of the present invention. The elements of the present invention

specifically the plate including a plurality of lenses for concentrating light which has been shown and described and which is claimed in claim 1, as currently amended, in combination with the plurality of light members has not been shown nor described in the references. Claim 1, as amended, is believed to be patentable and reconsideration is requested.

10. The addition of a lens to the filter plate of *Finizio et al.* is not an obvious combination of elements as suggested by the Examiner because the basic requirements of the *Finizio et al* device teaches away from the incorporation of a lens. *Finizio et al.* requires a broad illuminating beam of infrared light to illuminate a subject for operation of the camera for security surveillance. The addition of the lens and provide only partial illumination thereby rendering the *Finizio et al.* partially or entirely inoperative. The combination of elements of *Finizio et al.* and *Kouchi* is not an obvious combination which leads to the present invention but rather a forced bringing together of disparate elements which does not result in a functionally operative apparatus and does not lead to the present invention.

There is no teaching in the *Kouchi* and *Finizio* references take alone or in combination which leads to the structure of the present invention.

For the above reasons the application of the *Kouchi* and *Finizio et al* references is not considered to be appropriate.

In a famous footnote in *Hodosh v. Block Drug Co.*, 786 F2d 1136, 229 USPQ 182, 1987 (Fed. Cir., 1986), the Federal Circuit set out five principles; with citations to previous cases,

regarding obviousness determinations under Section 103. The footnote (as to the first four principles reads as follows:

Our comments on the district court's obviousness determination generally include the following tents of patent law that must be adhered to when applying § 103;

(1) the claimed invention must be considered as a whole (35 USC 103); see, e.g. *Jones v. Harty*, 727 F.2d 1524, 1529, 220 USPQ 1021, 1024 (Fed. Cir., 1984) (though the differences between claimed invention and prior art may seem slight, it may also have been taken the key to advancement of the art);

(2) the references must be considered as whole and suggest the desirability and thus the obviousness of making the combination (see, e.g., *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462, 220 USPQ 481, 488 (Fed. Cir. 1984);

(3) the references must be viewed without the benefit of hindsight vision afforded by the claimed invention (e.g. *W.I. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983));

(4) “ought to be tried” is not the standard with which obviousness is determined (*Jones, supra*, 727 F.2d at 1530, 220, USPQ at 1026).

The fifth tenet or principle deals with the presumption of validity and is not germane to the issues here involved.

It is submitted that the Examiner’s position in applying *Kouchi* and *Finizio et al.* is contrary to the above-quoted tenets of the Court of Appeals for the Federal Circuit, particularly the first three. When the claimed invention is considered fairly as whole, it is self-evident that Applicant’s invention is not rendered obvious by the cited prior art, whether considered alone or in combination.

The statutory presumption of 35 USC § 282 makes an invention presumptively non-obvious unless the Examiner can demonstrate the “the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skills in the art to which said subject matter pertains,” 35 USC § 103.

Obviousness is a legal conclusion based on four factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3)

the level of the ordinary skill when the invention was made; and (4) any other objective considerations including evidence of commercial success, copying, and a long-felt need in the industry. *Continental Can Co. v. Monsanto Co.*, 948 F2d 1264, 1270, 1273 (Fed. Cir. 1991) (citing *Graham v. Deere Co.*, 383 US 1.17 (1966)). The decision maker is not to apply hindsight, but must analyze obviousness from the viewpoint of a person skilled in the art prior to the disclosure of the present invention *Panduit Corp. v. Dennis Mfg., Co.* 810 F2d 1561, 1566 (Fed. Cir.), *cert denied*, 481 US 1052 (1987).

Objective evidence of non-obviousness (long-felt need, commercial success, copying must always be taken into account; it is not merely “icing on the cake”. *Hybrietch, Inc. v. Monoclonal Antibodies, Inc.*, 802 F2d 12367, 1380 (Fed. Cir. 1986), *cert denied*, 4580 US 947 (1987). The Federal Circuit has stated that:

(I)ndeed, evidence of secondary considerations may often be the most probative and cogent evidence in the record it may often establish that an invention appearing to have been obvious in light of the prior art was not.

The Examiner has attempted to reconstruct Applicant’s invention from selecting bits and pieces from *Kouchi* and *Finizio et al.* The cherry picking exercise is just the sort of hindsight

reconstruction which the Federal Circuit has warned against repeatedly. Nothing in the prior art suggests to a person or ordinary skill in the art to combine those elements in the way Applicant did to arrive at his invention. *Panduit Corp.* 810 F2d at 1568. The prior art existed for many years and yet those skilled in the art never created a light device having light concentrating device comparable to Applicant's. *See Id.* at 1577 (that skilled workers did not create (patented) invention, despite existence of elements in the prior art, is evidence of non-obviousness).

The objective evidence, such as whether the invention solves a long-standing problem, weigh strongly in favor of conclusion that Applicant's invention is not obvious. *Continental Can*, 948 F2d at 1273.

A Request for Continued Examination and a check in the amount of three hundred ninety five dollars (\$395.00) covering the associated fee are enclosed.

The status of the claims is as follows:

Claims 4 and 5 have been canceled.

Claim 1 and 7 have been previously presented.

Claims 2, 3 and 6 are original.

In view of the foregoing amendments, submissions and explanations, it is believed that claims 1 and 7, as amended, are in condition for allowance. An early Notice of Allowance on

the Application will be appreciated.

Courtesy, cooperation and skill of Examiner Rochelle BLACKMAN are appreciated and acknowledged.

Date: New York, New York
February 15, 2006

Respectfully,

HART, BAXLEY, DANIELS & HOLTON

By: Charles E. Baxley
Charles E. Baxley
Attorney of Record
USPTO Reg. 20,149
90 John Street, Third Floor
New York, New York 10038
Tel: (212) 791-7200
Fax: (212) 791-7276
E-mail: ceb@hartbaxley.com

CEB:rmm/15772 B

Enclosure: Request for Continued Examination Transmittal;
Check in the amount \$395.00.